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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/722,770

11/27/2000

Jae-Hong Park

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EXAMINER

MOORE JR, MICHAEL J

ART UNIT

PAPER NUMBER

2666

DATE MAILED: 01/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

OK

<b>Office Action Summary</b>	<b>Application No.</b> 09/722,770	<b>Applicant(s)</b> PARK ET AL.	
	<b>Examiner</b> Michael J. Moore, Jr.	<b>Art Unit</b> 2666	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 54 and 56 is/are rejected.
- 7) ☒ Claim(s) 4-53 and 55 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

Amendments made to the specification to obviate the objections of the previous Office Action are proper and have been entered.

### ***Claim Objections***

1. Claims **13, 25, 30, 43** are objected to because of the following informalities:

Regarding claim **13**, this claim presently depends on claim **13**. It is believed that this claim should depend on claim **10**.

Regarding claim **25**, on line 1, "step e a4)" should be "step ea4)".

Regarding claim **30**, on line 1, "step d 4)" should be "step d4)".

Regarding claim **43**, on line 1, "claims 42" should be "claim 42".

Appropriate correction is required.

Amendments made to the claims to obviate the informality objections of the previous Office Action are proper and have been entered.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim **56** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim **56** recites the limitations "step b3)" in line 5 and "step b4)" in line 6. There is insufficient antecedent basis for these limitations in the claim. These steps (b3 and

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b4) are located in claim 4, which claim 56 does not depend on. A suggestion to alleviate this problem would be to make claim 54 depend on claim 4 rather than claim 1.

Amendments made to the claims to obviate all other 35 U.S.C. 112, second paragraph rejections of the previous Office Action are proper and have been entered. These rejections have been withdrawn.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, and 54 are rejected under 35 U.S.C. 102(b) as being anticipated by Hokkanen (U.S. 5,675,628). Hokkanen teaches all of the limitations of the specified claims with the reasoning that follows.

Regarding claim 1, “A method for cell selection of an asynchronous mobile station in an asynchronous mobile communication system including the asynchronous mobile station and an asynchronous radio network, wherein the asynchronous radio network is interlocked with a core network” is anticipated by the method spoken of in column 7 pertaining to the system shown in Figure 6 containing mobile stations MS1 and MS2, base transceiver stations BTS1 and BTS2 coupled to base station controllers BSC1 and BSC2 (radio networks) and mobile switching centers MSC1 and MSC2 (core networks). “Storing information related to the core network transmitted from the asynchronous radio network in a memory or a user subscriber identity module (USIM) of

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the asynchronous mobile station before power-off of the asynchronous mobile station” is anticipated by the TMSI (information) shown in Figures 4 and 5 that is stored in a SIM.

“At power-on of the asynchronous mobile station, determining what type of the core network is interlocked by analyzing information of a core network discriminator” is anticipated by the reading of the stored TMSI (core network discriminator) upon inserting the SIM (power-on) into MS2 as spoken of on column 7, lines 48-61 as well as the bits 5-8 of octet 6 shown in the TMSI of Figure 4 that identify mobile radio system I as spoken of on column 7, lines 40-47. “Beginning any one of a GSM cell procedure and an ANSI cell procedure” and “finding a cell suitable for providing a service, based on a type of the core network that was determined” is anticipated by the cell roaming procedure spoken of on column 7, line 1 – column 8, line 19, using the GSM MAP standard for system I and the IS-41 standard for system II of Figure 6. Lastly, “performing a location registration of the mobile station according to the found cell in order to provide a service” is anticipated by the location attempt sent by MS2 upon insertion of the SIM spoken of on column 7, lines 62-66.

Regarding claim 2, “wherein in case the asynchronous radio network is interlocked with a GSM-MAP core network, the information related to the core network includes information of a core network discriminator by which a type of the core network is discriminated and a PLMN ID which includes a MCC and a MNC” is anticipated by the TMSI (information) shown in Figure 4 that contains bits 5-8 of octet 6 (core network discriminator) that identify mobile radio system I as well as bits in octets 5-7 that indicate a MCC and MNC.

Regarding claim **54**, "if the information of the core network discriminator indicates an asynchronous core network and a synchronous core network, selecting one of the asynchronous core network and the synchronous core network according to the information of the core network discriminator" is anticipated by the reading of the stored TMSI (core network discriminator) upon inserting the SIM (power-on) into MS2 as spoken of on column 7, lines 48-61 as well as the bits 5-8 of octet 6 shown in the TMSI of Figure 4 that identify mobile radio system I as spoken of on column 7, lines 40-47.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claim **3** is rejected under 35 U.S.C. 103(a) as being unpatentable over Hokkanen (U.S. 5,675,628). Hokkanen teaches the method of claim **1**. Hokkanen fails to explicitly

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teach information of a system identity (SID) and a network (NID) when an ANSI-41 core network is interlocked. However, Hokkanen teaches TMSI (information) shown in Figure 4 that contains bits 5-8 of octet 6 (core network discriminator) that identify mobile radio system I as well as bits in octets 5-7 that indicate a MCC and MNC in a GSM-MAP system. Hokkanen also teaches on column 7, lines 17-20 how mobile radio system II shown in Figure 6 may follow the IS-41 network standard or the GSM-MAP standard. At the time of the invention, it would have been obvious to someone skilled in the art to use identification fields (SID, NID) known in ANSI-41 in accordance with the GSM-MAP teachings of Hokkanen in order to provide identification of a mobile subscriber as stated on column 5, lines 9-10.

***Allowable Subject Matter***

9. Claims **4-53 and 55** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Claim **56** would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter:

Regarding claim **4**, Hokkanen (U.S. 5,675,628) teaches the method of claim **1**. Hokkanen fails to teach claimed steps b1) through b4) in claim **4**.

Regarding claims **5-53**, these claims are further limiting to claim **4** and are thus also allowable over the prior art of record.

Regarding claim **55**, Hokkanen teaches the method of claim **54**. Hokkanen fails to teach selecting an asynchronous or synchronous core network based upon a selection algorithm stored in the asynchronous mobile station.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lupien et al. (U.S. 6,389,008), Bharatia et al. (U.S. 6,615,037), Findikli et al. (U.S. 6,594,482), and Lamb et al. (U.S. 2004/0162068) are all references that contain material pertinent to this application.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.




Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Moore, Jr. whose telephone number is (571) 272-3168. The examiner can normally be reached on Monday-Friday (8:30am - 5:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema S. Rao can be reached at (571) 272-3174. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mjm MM

  
**FRANK DUONG**  
**PRIMARY EXAMINER**

Michael J. Moore, Jr.  
Examiner  
Art Unit 2666